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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,780	10/20/2000	Arturo A. Rodriguez	A-6694	8562

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EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2623	

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/693,780	RODRIGUEZ ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *104,106-108,110-115,119-121 and 123-126* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *104,106-108,110-115,119-121 and 123-126* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 June 2006 has been entered.

Priority

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application (60/214,987) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 104-124 of this application. In particular, while the earlier filling discloses the ability to provide supplemental content, the disclosure fails to provide adequate support as to the particular method by which the content is stored, transmitted, and locally processed for presentation as claimed.

3. With respect to applicant's claim for priority as a continuation-in-part to co-pending application No. 09/590,520, the earlier application discloses the overall system architecture of the utilized by the instant application (Figures 1-2) and illustrates similar GUI screen-shots. The claimed subject matter of the independent claims of the instant application wherein sequential data supplements are provided responsive to user in a manner that is synchronized with the video presentation does not appear to be disclosed in the parent

application. Accordingly, the claims of the instant application shall be examined in view of the filing date of the instant application (20 October 2000).

Response to Arguments

4. Applicant's arguments with respect to claims 104, 106-108, 110-115, 119-121, and 123-126 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5. Claims 123 and 124 are objected to because the particular recitation of "pop-up comments" and corresponding option referring to them lacks antecedence. For the purpose of art evaluation, the examiner shall presume that the claim has been amended to refer to the earlier recitation of "on-screen comments". Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to

point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 104, 106-108, 110, 111, 115, 120, 121, and 123-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Watts et al. (US Pat No. 6,324,694), and in further view of the Tabuchi et al. publication ('TV community system that enables users to build and maintain a community associated with the time-line of TV program').

In consideration of claim 104, Figure 1 of the White et al. reference illustrates a system which performs a "method implemented by a television set-top terminal ("STT") [14] (Col 2, Lines 53-62) that is "configured to receive a video program from a remote server" [12]. The method comprises "storing by the STT a plurality of streams corresponding to the video program from the remote server". The "plurality of streams" include "a first set of streams . . . including at least an audio streams and a video stream" corresponding to MPEG encoded video-on-demand program. The system is further capable of storing "supplementary data streams" as claimed (Col 2, Lines 18-48). The aforementioned streams are considered stored by the "STT" [14] in connection with being received and rendered by the terminal [14]. The system subsequently provides a "first selectable option to receive the video program from a plurality of video programs", "receives a first viewer input from a viewer being configured to select the first selectable option" and subsequently "communicates with the server by the STT via a first transmission channel to receive the plurality of streams" in connection with the ordering and delivery of a designated video-on-demand program (Col 4, Lines 12-58).

The reference, however, does not particularly disclose the details corresponding to the delivery of the requested video program in connection with the synchronous delivery, storage, and rendering of supplemental content as claimed.

In an analogous art pertaining to interactive video distribution services, the Watts et al. reference discloses a method for providing subsidiary data in conjunction with video programming. The reference discloses "storing by the STT a plurality of streams corresponding to [a] video program from the remote server" in association with the reception and processing of the received signals for display. The "plurality of streams includes a first set of streams [including at least an audio stream and a video stream]" (Col 3, Lines 34-36) and a "supplementary data stream that is different than the streams in the first set of streams . . . [and] correspond to supplementary information" (Abstract; Col 2, Line 64 – Col 3, Line 34; Col 4, Lines 23-33).

In association with the processing of the "plurality of streams", the reference discloses that the user is provided with a "second selectable option to receive the supplementary data stream" (Col 8, Lines 17-29) that is "responsive to receiving the first viewer input" as shall be further addressed in view of the combined references. After "receiving a second viewer input from the viewer responsive to providing the second selectable option", indicating that the "supplementary data stream" has been either accepted or "rejected . . . at the STT" by the user for presentation, the system "receives a respective sequential portion of each stream in the plurality of streams" comprising both the primary content and the subsidiary data "substantially simultaneously via a tuner in the STT tuned to the first transmission frequency channel" (Col 4, Lines 34-49; Col 5, Lines 21-33). Therefore, responsive to "receiving the

second viewer input corresponding to selecting the second selectable option" indicating a desire to utilize the supplemental content, the system "stores the sequential portions of the supplementary data stream and each stream in the first set of streams into respective sections of memory in the STT" (ex. [614/616/604]) as necessary to receive/process the incoming "plurality of streams" and "presents the sequential portions of the supplementary data stream and the audio stream and the video stream in the first set of streams in their respective decoded form simultaneously at a plurality of respective time intervals corresponding to respective portions of the video program" (Col 6, Line 53 – Col 7, Line 44; Col 8, Line 53 – Col 9, Line 19).

Responsive to "receiving the second viewer input corresponding to a viewer input that is different than a viewer input corresponding to selecting the second selectable option" so as to indicate a desire not to utilize the supplemental content, the system still "receives a respective sequential portion of each stream in the plurality of streams" comprising both the primary content and the subsidiary data "substantially simultaneously via a tuner in the STT tuned to the first transmission frequency channel" (Col 4, Lines 34-49; Col 5, Lines 21-33); however, the "supplementary data stream [is rejected] at the STT" given that it is not rendered for display in accordance with the user preferences. The system subsequently, "stores the sequential portions of each stream of the first set of streams into respective sections of memory in the STT" (ex. [616]) and "presents the sequential portions of the audio stream and the video stream of the video program of the first set of streams in their respective decoded form simultaneously at a plurality of respective time intervals corresponding to respective portions of the video program" in conjunction with the presentation of the video

program corresponding to only the primary content (Col 6, Line 53 – Col 7, Line 44; Col 8, Line 53 – Col 9, Line 19). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so utilize the supplemental content distribution teachings of Watts et al. in conjunction with the White et al. video distribution system teachings for the purpose of utilizing an effective method of providing a robust method for the provisioning of supplemental program information for television programming (Watts et al.: Col 1, Lines 21-45) including those programs which may be ordered by the subscriber.

With respect to the limitation such that the "second selectable option is first provided after receipt of the first viewer input and as a direct result of receiving the first user input", the limitation is met in light of the combined teachings. The White et al. reference discloses that the selected program does not appear in the electronic program guide until the program has been selected (Col 5, Lines 66 – Col 6, Line 2). The Watts et al. reference discloses that the program guide provides information for available programs wherein the user is operable to select an option to display additional content. Given that the "second selectable option" is only provided for available programs as taught by Watts et al. (Col 8, Lines 17-29), the particular "second selectable option" associated with the particular presentation of supplemental content for the newly ordered program cannot occur until "after receipt of the first user input and as a direct result of receiving the first user input" associated with making the program available for viewing. It subsequently logically follows that if the program does not appear in the program guide until it has been selected by the "first selectable option" then the "second selectable option" would appear "responsive to receiving the first viewer . . .

[such that the] second selectable option is first provided after receipt of the first user input and as a direct result of the first user input" in conjunction with the provisioning of supplemental content for the ordered program. For example, until a viewer orders the movie "Ronin", the particular listing does not appear within the program guide (White et al.: Col 5, Line 59 – Col 6, Line 9). Accordingly, the "second selectable option" associated with providing supplemental content for the ordered movie 'Ronin' is "first provided after receipt of the first viewer input and as a direct result of receiving the first user input" in association with user ordering the movie 'Ronin' (ex. first user input).

The Watts et al. discloses that the supplemental content data can be any form of multimedia data designed to supplement the primary video program (Col 4, Lines 24-27). The "second selectable option", as aforementioned, is associated with the presentation or non-presentation of supplemental content. However, the Watts et al. reference is silent with respect to the supplemental information necessarily comprising "on-screen comments . . . from at least one other viewer". In an analogous art pertaining to interactive video distribution services, the Tabuchi et al. publication provides evidence of "supplementary data streams comprising on-screen comments . . . including comments from at least one other viewer" which are either synchronously or asynchronously displayed with a video program (Section 4.5 Application examples of TV community system). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined references such that the "second selectable option is associated with an option to display on-screen comments; and wherein the supplementary data stream comprises on-screen comments, the on-screen comments including comments from at least one other

viewer" for the purpose of providing the user with the opinion to enable supplemental content which advantageously promotes television communities or active participation with other viewers (Tabuchi et al.: Section 1 Introduction).

In consideration of claim 106, the Tabuchi et al. publication discloses "presenting the supplementary data stream during the plurality of respective time intervals corresponds to the appearance time of a visual object" such as that corresponding to a particular scene "contained in the video program" (Tabuchi et al.: Section 4.5 Application examples of TV community system).

Claim 107 is rejected wherein "presenting the sequential portions of the supplementary data stream at a plurality of respective time intervals corresponding to respective portions of the video program is a time-synchronized composition of the supplementary data stream and the video program according to time stamp specifications" as defined by the supplemental content (Watts et al.: Col 7, Lines 8-29).

Claim 108 is rejected wherein "at least a portion of the supplementary data stream and at least the respective sequential portion of each stream in the plurality of streams" or portions corresponding to the video-on-demand presentation are "presented by the STT as a television signal" (White et al.: Col 3, Lines 9-12; Watts et al.: Col 3, Lines 17-21).

Claim 110 is rejected wherein the "video program comprises a video-on-demand program established over a dedicated network session between the remote server and the STT" (White et al.: Col 3, Line 66 – Col 4, Line 11; Col 4, Line 38 – Col 6, Line 15).

Claim 111 is rejected wherein "at least a portion of the supplementary data stream" and "at least a respective portion of each stream in the first set of streams" or that portion

corresponding to the video-on-demand presentation are "received substantially simultaneously by the STT from a single tuned transmission channel via the tuner in the STT" (White et al.: Col 3, Line 66 – Col 4, Line 11; Watts et al.: Col 3, Lines 22-33; Col 4, Lines 49; Col 5, Lines 29-33).

In consideration of claim 115, the Watts et al. reference is not limiting such that the same portion of supplemental content cannot be reused throughout the presentation for the purpose of advantageously providing the user with several opportunities to access relevant supplemental content. For example, Robert DeNiro stars in and appears in several scenes in the movie "Ronin" (White: Figure 4). Presuming that the supplemental content to be inserted was biographical information regarding Robert DeNiro (Watts et al.: Col 4, Line 28-31) to be inserted during certain points within the presentation, then "at least one portion of the supplemental stream of data" (ex. biographical information) would be "associated to and presented during a first interval" (ex. scene 1) and a "second interval of the presentation of the video program" (ex. scene 2) in order to advantageously provide the user with an additional opportunity to access the biographical information in case they did not notice that the information was available the first time it was presented.

Claim 120 is rejected wherein the "video program" or video-on-demand movie associated with the "first plurality of streams corresponding to an entirety of the stored video program" implicitly "corresponds to a single consumable version of the video program in the remote server . . . corresponding to the released form of the video program" such as the movie 'Ronin' (White et al.: Figure 4).

Claim 121 is rejected wherein the "first selectable option is associated with a video title" such as the movie 'Ronin' (White et al: Col 4, Lines 12-38).

Claim 123 is rejected in light of the combined references or more particularly the teachings of Watts et al. In particular, "responsive to receiving the second viewer input corresponding to selecting the second selectable option" associated with the enablement of supplemental content, the method comprises "presenting an indication that the option to display 'on-screen' comments has been activated" in association with the particular presentation of the supplemental content. The method subsequently may involve "receiving a third user input for de-activating the 'on-screen' comments" (which had been previously activated) whereupon the system "rejects the supplementary data stream a the STT" should the user no longer desire to watch the program with the supplemental content (Col 8, Lines 17-29).

Claim 124 is rejected in light of the combined references. In particular, "responsive to receiving the second viewer input corresponding to a viewer input that is different than a viewer input corresponding to selecting the second selectable option" associated with the enablement of supplemental content, the method comprises "presenting an indication that the option to display 'on-screen' comments has been de-activated" in association with lack of display of the non-presentation of the supplemental content or the particular display state of the toggled user-selectable icon (Watts et al.: Col 8, Lines 17-29). The method subsequently may involve "receiving a third user input for activating the 'on-screen' comments" (which had been previously deactivated) whereupon should the viewer rewind [76D] the video presentation (White et al: Figure 5), the method involves "presenting the sequential portions

of the originally rejected supplementary data stream in its decoded form at a plurality of respective time intervals corresponding to the respective portions of the video programming" (Watts et al.: Col 6, Line 53 – Col 7, Line 44; Col 8, Line 53 – Col 9, Line 19) as if the user had originally selected the option to view the supplemental content.

Claim 125 is rejected wherein the method further comprises "enabling the viewer to add comments" (Tabuchi et al.: Section 4.5 Application examples of TV community system).

Claim 126 is rejected wherein the method further comprises "receiving and storing comments added by the viewer; and transmitting the comments added by the viewer to the remote server after the sequential portions of the supplemental data stream and the audio stream and the video stream have been presented" (Tabuchi et al.: Section 4.1 Concept of TV community system; Section 4.3 Information sharing technique webLacco).

9. Claim 114 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Watts et al. (US Pat No. 6,324,694), in view of the Tabuchi et al. publication, and in further view of Abecassis (US Pat No. 6,408,128).

In consideration of claim 114, the Watts et al. reference discloses that the system may use a variety of means to identify when to present supplementary content during a video presentation. The reference, however, does not explicitly identify that the video program comprises "video chapters". In an analogous art related to field of media-on-demand, the Abecassis reference provides a showing that video-on-demand presentations comprise "video chapters" (Col 63, Lines 29-42). Therefore, it would have been obvious, if not inherent to the video-on-demand presentation, for one having ordinary skill in the art at the time the invention to utilize "video chapters" in a video-on-demand presentation for the purpose of

utilizing a logical organization to a narrative which facilitates the quick selection of particular scenes. Subsequently, the Watts et al. reference implicitly "presents the sequential portions of the supplementary data stream at a plurality of respective time intervals in relation to a starting point in the video program, the starting point being a video chapter" given that any supplemental content presented during a video program comprising "video chapters" is somehow being presented in relationship to a staring point of a "video chapter" (ex. before, during, or after).

10. Claims 112 and 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Watts et al. (US Pat No. 6,324,694), in view of the Tabuchi et al. publication, and in further view of Adams (US Pat No. 6,378,130).

In consideration of claims 112 and 113, it is unclear if the combined references necessarily encrypt the "supplementary data stream" as well as the "audio and video stream" associated with the video-on-demand program wherein the information is "transmitted over the same transmission channel" or "radio-frequency channel with a specified center frequency wherein data carried in said transmission channel is modulated via quadrature amplitude modulation (QAM)".

In an analogous art related to field of media-on-demand, the Adams reference discloses a VOD delivery architecture wherein multiplexed signals (MPEG) associated with the video presentation including HTML content are distributed via a "single tuned transmission channel" and are "received substantially simultaneously" via the "tuner in the STT" [41] (Adams: Col 10, Line 40 – Col 11, Line 19). The "supplementary data stream, audio stream, and video stream are encrypted and transmitted over the same transmission channel"

(Adams: Col 3, Lines 31-38) wherein the "transmission channel is a radio-frequency channel with a specified center frequency, wherein data carried in said transmission channel is modulated via quadrature amplitude modulation (QAM) (Adams: Figure 5; Col 10, Line 40 – Col 11, Line 19).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize "single tuned transmission channel" as taught by Adams for the purpose of utilizing a VOD delivery architecture that is much less complex than prior media delivery systems providing the same services and provides greater flexibility with respect to the system capacity may be changed (Adams: Col 7, Lines 8-16).

11. Claim 119 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Watts et al. (US Pat No. 6,324,694), in view of the Tabuchi et al. publication, and in further view of Dunn et al. (US Pat No. 5,861,906).

In consideration of claim 119, the combined references disclose "configuring . . . initial transmission to the STT of the video program and the supplementary data stream via a first transmission channel", "receiving the initial transmission of the video program and the supplemental data stream in the STT during" the video-on-demand presentation "via a tuner in the STT tuned to the first transmission channel" and "presenting a respective portion of the initial transmission of the video program and the supplementary data stream simultaneously at a plurality of respective time intervals corresponding to respective portions of the video program" (Watts et al.: Col 3, Lines 56-58; Col 4, Lines 34-49; Col 5, Lines 21-33). The references, however, are silent as to the particular establishment of "configuring a rental viewing period" associated with a video-on-demand presentation. In an analogous art related

to field of media-on-demand, the Dunn et al. reference discloses "configuring a rental viewing period" for video-on-demand presentations (Col 12, Lines 1-17). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to advantageously provide the cable provider with the ability to flexibly define rental periods as they wish.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Harrison (US Pat No. 5,694,163) reference discloses a system and method for displaying and contributing viewer comments while watching a television program.
- The Schindler (US Pat No. 6,081,830) reference discloses a system and method for automatically linking television programs to specific computer chat rooms.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Scott Beliveau
Examiner
Art Unit 2623

SEB
June 21, 2006